

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed July 28, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 102(b)**

#### **A. Rejection Under Ishii**

Claims 1-4, 14, 32, and 33 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Ishii, et al. ("Ishii," U.S. Pat. No. 5,265,083). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

As is noted above, Applicant's independent claims have been amended. Accordingly, Applicant submits that the rejection is moot as having been drawn against the claims in a previous form. Regardless, Applicant briefly discusses the claims and the Ishii reference for the Examiner's consideration.

Regarding claims 1 and 32, Ishii does not teach a compact disc holder that is "integrated with an exterior surface" of a portable electronic device. Instead, Ishii teaches an internal CD drive that reads a CD. Claims 1-4, 14, 32, and 33 are believed to be allowable over Ishii for at least this reason.

**B. Rejection Under Howell**

Claims 1-3, 14, 22, 23, 26, 28, 32, and 33 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Howell (U.S. Pat. No. 6,621,691). Applicant respectfully traverses this rejection.

As is noted above, Applicant's independent claims have been amended. Accordingly, Applicant submits that the rejection is moot as having been drawn against the claims in a previous form. Regardless, Applicant briefly discusses the claims and the Howell reference for the Examiner's consideration.

Regarding claims 1, 22, and 32, Howell does not teach a compact disc holder that is "integrated with an exterior surface" of a portable electronic device, or "means integrated with the portable electronic device for securing a compact disc on an exterior surface of the portable device". Instead, Howell teaches an internal CD drive that reads/writes to a CD. In particular, the CD drive is "internal" to the lid 28 (see all Howell Figures) and cannot be legitimately considered to be provided on an "exterior surface" of the "electronic device". Claims 1-3, 14, 22, 23, 26, 28, 32, and 33 are believed to be allowable over Howell for at least this reason.

**C. Rejection Under Cloran**

Claims 1-3, 14, 15, 22, 23, 26, 28, 29, 32, and 33 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Cloran, et al. ("Cloran," U.S. Pat. No. 5,950,822). Applicant respectfully traverses this rejection.

As is noted above, Applicant's independent claims have been amended. Accordingly, Applicant submits that the rejection is moot as having been drawn against the claims in a previous form. Regardless, Applicant briefly discusses the claims and the Cloran reference for the Examiner's consideration.

Regarding claims 1, 15, 22, 29, and 32, Cloran does not teach a compact disc holder that is “integrated with an exterior surface” or “unitarily formed” with “an exterior mounting surface” of a portable electronic device, or “means integrated with the portable electronic device for securing a compact disc on an exterior surface of the portable device”. Instead, Cloran teaches that a compact disc holder can be “attached” to such a surface instead of being integrated into the surface. Cloran, column 4, lines 58-62. Claims 1-3, 14, 15, 22, 23, 26, 28, 29, 32, and 33 are believed to be allowable over Cloran for at least this reason.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

### **A. Rejection of Claims 1-3, 13-15, 22, 23, 26-29, 32, and 33**

Claims 1-3, 13-15, 22, 23, 26-29, 32, and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cloran in view of Wolff (U.S. Pat. No. 5,933,772). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

As is mentioned above, Cloran does not teach a compact disc holder that is "integrated with an exterior surface" or "unitarily formed" with "an exterior mounting surface" of a portable electronic device, or "means integrated with the portable electronic device for securing a compact disc on an exterior surface of the portable device". Instead, Cloran teaches that a compact disc holder can be "attached" to such a surface. Cloran, column 4, lines 58-62. Wolff's teaching of a "coin holder" attached to a beeper does not overcome Cloran's teaching of attaching a CD holder to another object. First, Cloran explicitly teaches away from an integrated or unitarily-formed holder. Second, Wolff's teaching is for a coin holder, not a CD holder. A person having ordinary skill in the art of the CD holders would not look to Wolff's coin holder to modify Cloran's CD holder.

### **B. Rejection of Claims 4 and 16**

Claims 4 and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cloran and Wolff in view of Cerda-Vilaplana et al. (“Cerda-Vilaplana,” U.S. Pat. No. 5,933,772) or Sommi (U.S. Pat. No. 5,570,791). Applicant respectfully traverses this rejection.

As is identified above, neither Cloran nor Wolff teaches a compact disc holder “integrated with” or “unitarily-formed with” an exterior surface of a portable electronic device. In that neither Cerda-Vilaplana nor Sommi remedy this deficiency of the Cloran and Wolff references, Applicant respectfully submits that claims 4 and 16, which depend from claims 1 and 15, respectively, are allowable for at least the same reasons that claims 1 and 15 are allowable.

### **III. Canceled Claims**

Claims 5-12, 17-21, 24-25, 30-31, and 34-35 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.


### **IV. New Claims**

Claims 36-40 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

10-26-05  
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Signature